UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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In re Application of Marcelo Dornelas et al. :
Serial No.: 09/578,194 :
Filed: May 24, 2000 : PETITION DECISION
Attorney Docket No.: 026-1 :

This is in response to applicants' petition, filed December 9, 2002 under 37 CFR 1.144, requesting withdrawal of the restriction requirement set forth by the examiner.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on May 24, 2000. The application, as filed, contained claims 1-24. On August 13, 2001, the examiner mailed an Office action including a restriction requirement dividing the claims into 2 groups, and requiring a further election of a single species of plant and of a single nucleic acid sequence for examination. In the response filed June 11, 2002, applicants elected group II, and further elected *Arabidopsis* as the plant species and the dzeta ASK gene as the nucleic acid sequence to be examined, with traverse. Applicants traversed the restriction requirement on the same grounds presented in the petition, discussed below. On August 30, 2002 the examiner mailed a first Office action on the merits wherein the restriction requirement was made final.

DISCUSSION

Applicants have not traversed the restriction between groups I and II. The traversal concerns the further election of species within the elected group. Applicants appear not to understand that these are elections of species, not restriction, and that additional species will be examined should the elected species prove to be allowable. Nevertheless, applicants' arguments are addressed below.

Applicants argue that the examiner has not shown that the inventions are independent or distinct, or that it would be a serious burden to search all of the claimed species. This argument is not persuasive because these are the criteria used for determining whether restriction is proper, not election of species.

Applicants argue that all of the recited nucleotide sequences should be searched, citing MPEP 803.04. This argument is not persuasive for two reasons. First, MPEP 803.04 states that, in

certain cases, *up to* 10 sequences may be searched. This does not require the examiner to search 10 sequences. Second, the claims in the instant application are clearly dissimilar to those in the examples found in MPEP 803.04, and therefore the partial waiver of 37 CFR 1.141 does not apply in this case.

Applicants argue that the different plant species recited in the claims do not have mutually exclusive characteristics. This argument is not persuasive because, again, the cited section of the MPEP refers to restriction practice, not election of species. As stated in the original restriction requirement, "Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case." Absent any such evidence or admission, the examiner's position is not improper. Note that in the petition, applicants state, "The applicant is not suggesting...that the species are not patentably distinct" (p. 3, line 5).

DECISION

Applicants' petition is **DENIED** for the reasons set forth above.

The time period for response continues to run from the mailing date of the final rejection.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-4205 or by facsimile transmission at (703) 746-5006.

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